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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/051,340
Filing Date: January 18, 2002
Appellant(s): CHAUVIN ET AL.

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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/3/2010 appealing from the Office action mailed

9/30/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 23, 25-29, 34, 37-41, and 45 are finally rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW

GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the

Appendix to the appellant's brief.

(8) Evidence Relied Upon

7013288	*Reifel* et al.	3/14/2006
20030014331	*Simons*	1/16/2003
6907401	Vittal et al.	6/14/2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-29, 31, 32, and 34-43 are rejected on the ground of nonstatutory obviousness-

type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 7.275.044.

Although the conflicting claims are not identical, they are not patentably distinct from each other

because they only contain minor differences in the claim language. Taking claim 1 as the

exemplary claim from the instant application and the '044 patent, both claims are directed to a

method for providing photo services to a user. Both claims disclose maintaining business

relationship data between service providers and business entities and providing specific services

based on this maintained relationship data.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. Claim 23 lacks proper antecedent basis for "the relationship data" (last line of the

claim).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

I.   CLAIMS 23, 25-27, 29, 34, 37, 39-41, AND 45 ARE REJECTED UNDER 35 U.S.C §103(A) AS BEING UNPATENTABLE OVER *REIFEL* ET AL, U.S PATENT NO. 7.013.288 [*"REIFEL"*] IN VIEW OF *SIMONS*, U.S. PATENT PUBLICATION NO. 2003|001331 [*"SIMONS"*].

All citations in the following claim mappings are to *Reifel* unless otherwise noted.

Claims 23, 34, and 45

Reifel as modified by *Simons* discloses a method, system, and storage device comprising:

providing a network service on a network [Figure 1];

providing access for a user to a network server via the network service, the user accessing the network server, by using an order terminal connected to the network, for ordering products [Figure 1 | Figure 3 «item 308» | Figure 13 «items 20, 25»]; said order terminal associated with one of a plurality of business entities [*see* Response to arguments *supra* | column 15 «lines 36-44» | column 16 «liens 19-24»: business entity controls a home PC by running a software application via a browser to access photo services | Fig. 13 «items 20, 25»];

in response to a user coupling a portable digital storage device to a network connected order terminal [column 3 «lines 35-39»], electronically reading the portable digital device, the portable digital storage device associated with one of a plurality of service providers and having an image stored thereon [column 3 «line 53» to column 4 «line 4» | column 19 «lines 18-26 and 61-65: kiosk controlled by a service provider providing the storage device], said one of the plurality of service providers identified by electronically reading a code stored on the portable digital storage device [column 12 «lines 29-38» | column 13 «lines 10-14» : camera-related information stored on the camera], the plurality of service providers each having a predefined

business relationship with said plurality of business entities [column 5 «lines 28-44» | column

12 «line 6»];

maintaining a relationship directory indicating a ranking of the predefined business

relationships in a database coupled to the communication network [column 5 «lines 28-44» |

column 12 «line 6» : camera provider can restrict the vendors from which the consumer can

receive services or the consumer can pay a higher fee to use those vendors not associated with

the manufacturer | *Simons*, 0087, 0088 & Table 1: categorizing ranked merchants based on their

business relationships]; and

displaying to the user an order screen on said order terminal in response to reading the

code stored on the portable digital storage device, the order screen including primary purchasing

information provided by at least two of said plurality of business entities from which the user can

order a product and/or service related to the image stored on the portable digital storage device,

the primary purchasing information being modified in response to a ranking of a predefined

business relationship between said one of the plurality of service providers and said at least two

of the plurality of business entities [column 5 «lines 11-19 and 28-44» | column 12 «line 6» :

Reifel discloses that a user may elect, by activating links to print houses or vendors that are

approved by the camera provider or decide to use a lower rated vendor and pay a fee], wherein a

modification of the primary purchasing information includes listing first on the order screen one

of the at least two of the plurality of business entities that has a better ranking than another one

of the at least two of the plurality of business entities, according to the relationship data in the

database [*Simons*, 0086-0088: the entity operating the server modifying the listing of merchants

based on their relationship to the entity].

While *Reifel* discloses at least two service providers (print houses), one of which has a higher ranking than the other [column 5 «lines 28-44» : a service provider that is preferred by the manufacturer of the device has a "higher" ranking than a service provider that is not preferred], *Reifel* does not expressly disclose modifying an order screen such that the higher rated service provider is displayed first. However, this feature was well known in the art at the time of Applicant's invention as taught by *Simons*.

Simons is directed to a system for providing purchasing information (in the form of search results). As indicated in the foregoing mapping, *Simons* discloses an order screen whereby a user may select from a list of ranked business entities or merchants and discloses that the order in which the business entities are displayed is based on the specific business relationship. It would have been obvious for one of ordinary skill in the art to have applied *Simon*'s ordering features to *Reifel*'s teachings.

As noted above, *Reifel* discloses two service providers that have different relationships to a business entity. It would have been obvious for one of ordinary skill in the art, in reading *Simons*, to have organized the order screen such that the preferred service provider (the provider in which the manufacturer has a relationship) is listed prior to the business entity with whom the manufacturer does not have a relationship [column 5 «lines 41-45»]. One would have been motivated to provide such a modification to *Reifel*'s photo service because displaying preferred providers first increases the possibility that the customer will see the better prices for printing the photographs and benefit the business entities with whom have a better business relationship.

Claims 25 and 37

Reifel as modified by *Simons* discloses modifying the primary purchasing information to include a lower purchase price from service providers if said ranking is better [column 5 «lines 28-44» | column 12 «line 6» : consumers receive cheaper prints at approved print houses or vendors].

Claims 26 and 39

Reifel as modified by *Simons* discloses said order terminal comprising one of the following, an automated teller machine, a kiosk, a personal computer, or a wireless device [Figure 13 «item 20»].

Claims 27 and 41

Reifel as modified by *Simons* discloses said portable digital storage device comprising one of the following: optical disc, magnetic floppy disk; flash memory device, or a digital camera [Figure 13 «items 5, 20»].

Claims 29 and 40

Reifel as modified by *Simons* discloses said one of a plurality of business entities provides one or more of the following: local printing of digital images, remote printing of digital images, on-line storage of digital images, providing digital storage media containing digital images, and providing associated goods and/or services with respect to hard copy prints [column 5 «lines 28-44»].

II.   **CLAIMS 28 AND 38 ARE REJECTED AS BEING UNPATENTABLE OVER *REIFEL* AND *SIMONS*, IN VIEW OF VITTAL ET AL, U.S PATENT NO. 6.907.401 ["VITTAL"].**

Claims 28 and 38

Reifel as modified by *Simons* does not expressly disclose displaying different types of products and/or service on the order screen for the user to select, wherein some of the products and/or services are displayed more prominently based on said ranking of a predefined business relationship between said one of the plurality of service providers and the merchant. However, Vittal discloses that such a feature was well known at the time of Applicant's invention.

Vittal specifically discloses modifying purchasing information based on relationships between the merchant and a service provider such that the merchant's product is displayed (advertised) more prominently [column 1 «lines 55-64» where : being advertised more prominently implies that that they are "displayed first"]. It would have been obvious to one of ordinary skill in the art to modify *Reifel* to include Vittal's teachings of prominently displaying provider products on a merchant's site based on a contract between the merchant and the service provider. One would have been motivated to modify *Reifel* as such functionality improves upon *Reifel*'s merchant-service provider system by increasing the number of options in the merchant-provider contract.

(10) Response to Argument

Appellant argues that (1) *Reifel* in view of *Simons* does not disclose an order terminal that is associated with one of a plurality of business entities; (2) a database that contains a ranking of relationships between each of the plural business entities and each of the plural service providers;

and (3) there is proper antecedent basis for the term "the relationship data" in claim 23.

Appellant's arguments should not be found persuasive for the following reasons.

A.   *Reifel* discloses an order terminal associated with a business entity as described in Appellant's specification.

Reifel teaches that a user may use a home PC (i.e., order terminal) to access a web site

associated with print houses in order to select and print specific images [column 5 «lines 16-

19»]. When the terminal accesses the print house's web site [column 5 «lines 45-48»], the

terminal becomes "associated" with the print house.

This interpretation is consistent with Appellant's specification which at several locations

describes a user utilizing a desktop PC to place an order. *See*, e.g., pg. 3, ll. 12-16, pg. 14, ll. 13-

17, pg. 24, ll. 7-17, pg. 26, ll. 14-21. The last citation at page 26 is particularly illustrative

because it states that "the customer users *their* desktop PC 28 as an order terminal." Appellant's

specification provides no description of how customer's desktop PC may be associated with a

business entity.

Reifel discloses that a user directing his computer to a web site (i.e., digital storage

location) that may be run by different business entities such as a camera provider or the order

taker. *Reifel*, col. 15, ll. 36-44. Under the current interpretation, when a user uses a desktop PC

to access the web site that is run the business entity, the desktop becomes "associated" with the

business entity through its web site. The web site then directs a user's order to an appropriate

service provider (e.g., a print house for printing the images).

Appellant takes issue with this interpretation and argues that the Appellant's application

states that the order terminal is associated with a business entity independently of accessing a

network web site and that the order terminals are associated with business entities if the business

entities "control" the order terminal.

Appellant's arguments should not be persuasive because Appellant is arguing limitations

not in the claims. There is no language in the claims that require interpreting the order terminal

to be associated with the business entity prior to network connection or that the business entity

must control the order terminal.

Moreover, Appellant's arguments ignore the portions of Appellant's specification which

describe a user using "their" desktop PC and not a "business entity" desktop PC. Pg. 26, ll. 14-

21. In this embodiment of Appellant's invention, the user's desktop PC is only "associated" with

business entity accessing pictures on at a digital storage location (e.g., PictureCD). Pg. 23, ll.

19-26. This embodiment is similar to *Reifel*'s teaching which teachings a user desktop PC at a

digital storage location such as a web site that is run by the business entity.

For the foregoing reasons, *Reifel*'s teaching of a desktop PC reads on Appellant's order

terminal as claimed.

**B.   The combination of *Reifel* and *Simons* discloses a database that contains a
          ranking of relationships between each of the plurality of business entities and
          each of the plurality of service providers.**

It should first be noted that Appellant's specification is completely silent as to the feature

of "ranking [of] a relationship between" the plural business entities and the plural service

providers. Appellant's specification, at Fig. 5, illustrates relationships between providers and

business entities and specifies whether the providers are "friendly," "neutral," or "hostile" to each

entity. So, in actuality, the claimed "ranking" is closer to a preference between the providers and

the entities (i.e., whether the provider prefers certain entities over another). The claim term is interpreted consistent with this description.

The rejection relied on the combination of *Reifel* and *Simons* to teach this limitation. Specifically, *Reifel* discloses that a user may elect, by activating links to print houses or vendors that are approved by the camera provider or decide to use a lower rated vendor and pay a fee. Col. 5, ll. 11-19 and 28-44. *Reifel*'s camera provider reads on a business entity and the print houses read on the claimed service providers.

The camera provider's preferences for particular print houses are placed in a consumer profile which is then stored in a customer database. Col. 11, ll. 62-64 & Col. 12, l. 8. The preferences of particular print houses represent a "ranking" of the relationship between those print houses and the camera provider. *Reifel* teaches all of the claimed limitations except for the plural business entities.

Simons further discloses establishing relationships between a plurality of business entities (e.g., merchants) and a service provider. 0086-0088. These relationships are then stored at the one system server and ranked based on their relationship with the different servers. 0086-0088. The combination of *Reifel* and *Simons* therefore teaches the limitation of providing a database that contains a ranking of a relationship between plural business entities and plural service providers as claimed.

C.   **There is no antecedent basis for "the relationship data."**

Appellant argues that the term "relationships in a database" provides the antecedent basis for the term "the relationship data in the database." A claim is indefinite when it contains words or phrases whose meaning is unclear. *MPEP § 2173.05(e)*. It is not immediately clear that

"relationship data" is intended to refer to "relationships in a database." This rejection would be

easily overcome to amend the claim to recite "relationship data in a database" which would

provide proper antecedent basis.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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